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EXAMINER

BADAWI, SHERIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID AARON CROWTHER, RAVINDRA KUMAR RAMA
REDDY, ANDREW EUGENE ADKINS, and NANYU CAO

Appeal 2009-005489
Application 10/519,856
Technology Center 2100

Decided: March 1, 2010

Before JOSEPH L. DIXON, THU A. DANG, and
STEPHEN C. SIU, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellants appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-11. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

I. STATEMENT OF THE CASE

The Invention

The invention at issue on appeal relates to a method for managing a plurality of storage devices (Spec. 1).

The Illustrative Claim

Claim 1, an illustrative claim, reads as follows:

1. A method for managing at least one storage device, comprising the steps of:
 - (a) identifying the at least one storage device;
 - (b) establishing a database containing information about the identified at least one storage device, wherein the information about the identified at least one storage device includes operating characteristics of the identified at least one storage device;
 - (c) providing to the user a graphical user interface in accordance with the information in the database, the graphical interface displaying at least one menu option for the identified at least one storage device for the user to select at least one of (i) display of the information about the identified at least one storage device and (ii) execution of at least one process to control the operation of the at least one storage device;
 - (d) processing the user-selected menu option, said processing further including: determining if the requested execution of the at least one process complies with the operational rules for the identified at least one storage device, and if not, blocking execution of the at least one process, and generating an error message; and
 - (e) automatically updating the graphical user interface in response to the processing of the user-selected menu option.

The References

The Examiner relies on the following references as evidence:

Lavallee	US 7,003,527 B1	Feb. 21, 2006
Baldwin	US 7,171,624 B2	Jan. 30, 2007

The Rejection

The following rejection is before us for review:

Claims 1-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Baldwin and Lavallee.

II. ISSUE

The issue before us is whether claims 1-11 are sufficiently definite in claim scope so as to evaluate the patentability of the claims in view of the cited prior art.

III. PRINCIPLES OF LAW

Prima Facie Case of Unpatentability

Appellants have the opportunity on appeal to the Board of Patent Appeals and Interferences (BPAI) to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (citing *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

Claim Interpretation

The claim construction analysis begins with the words of the claim. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). Absent an express intent to impart a novel meaning to a claim term, the words take on the ordinary and customary meanings attributed to them

by those of ordinary skill in the art. *Brookhill-Wilk 1, LLC. v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed. Cir. 2003) (internal citations omitted).

Obviousness

“Obviousness is a question of law based on underlying findings of fact.” *In re Kubin*, 561 F.3d 1351, 1355 (Fed. Cir. 2009). The underlying factual inquiries are: (1) the scope and content of the prior art, (2) the differences between the prior art and the claims at issue, (3) the level of ordinary skill in the pertinent art, and (4) secondary considerations of nonobviousness. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007).

35 U.S.C. §112, second paragraph

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).

IV. FINDINGS OF FACT

The following findings of fact (FFs) are supported by a preponderance of the evidence.

Specification

1. The Specification provides that the library associated with each of the storage devices 12¹-12³ typically includes the device operating characteristics associated with that storage device. The device operating

characteristics includes at least one of: (a) operational rules, (b) commands, and (c) processing routines (Spec. 3, ll. 17-18).

2. The Specification also provides that “a Communication Object Model (COM/Distributed Communications Object Model (DCOM) layer 20 . . . takes the form of a memory that includes specific configuration rules for each of the storage devices 12₁-12₃,” (Spec. 3, ll. 26-28) and the configuration rules are determined from the information in the library of the corresponding storage device to ensure that the requested operation complies with the configuration rules (Spec. 3, l. 29-Spec. 4, l. 6).

V. ANALYSIS

We first consider the definiteness of the scope of claims 1-11. Neither the Appellants nor the Examiner considers the issue in the Brief and the Answer.

With respect to claims 1-11, we are uncertain whether the Appellants intend to claim “the operational rule” or “the configuration rule” in step (d) of independent claim 1 and in element (c) of independent claim 7. Furthermore, when we consult the Summary of Claimed Subject Matter provided by the Appellants, we find that the Appellants map “the operational rules” as the configuration rules (App. Br. 3). However, we find that the operational rules are included in the operating characteristics stored in the library (FF 1), and “the configuration rules” are included in DCM/DCOM object layer 20 and determined from the information stored in the corresponding library for each device (FF 2). The two rules appear to be different set of rules because they are stored in different places and have

different functions. Therefore, we are left to speculate as to the scope of claims 1-11, especially the step (d).

While we might speculate as to what is meant by the claim language, our uncertainty provides us with no proper basis for making the comparison between that, which is claimed and the prior art, as we are obliged to do so. Rejections under 35 U.S.C. § 103 should not be based upon "considerable speculation as to meaning of the terms employed and assumptions as to the scope of [the] claims." *In re Steele*, 305 F.2d 859, 862 (CCPA 1962). When no reasonably definite meaning can be ascribed to certain terms in a claim, the subject matter does not become obvious, but rather the claim becomes indefinite. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). Accordingly, we are constrained to reverse, *pro forma*, the Examiner's rejections of claims 1-11 under 35 U.S.C. § 103. We hasten to add that this is a procedural reversal rather than the one based upon the merits of the Section 103 rejection.

VI. NEW GROUNDS OF REJECTION

We enter a new ground of rejection of claims 1-11 under 35 U.S.C. § 112, second paragraph wherein the claims do not particularly point out and distinctly claim Appellants' invention.

As already noted, the Appellants have not provided adequate guidance as to what the Appellants intend the claim language to cover with respect to those different limitations, such as the operational rules or the configuration rules.

Due to the uncertainty of the scope of the claim language and the fact that those claimed elements are amenable to two or more plausible claim constructions, we enter a new ground of rejection of claims 1-11 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the Appellants consider to be the invention.

VII. CONCLUSION

We reverse, *pro forma*, the Examiner's prior art rejection of claims 1-11. We enter a new ground rejection of claims 1-11 under 35 U.S.C. § 112, second paragraph.

VIII. DECISION

We reverse, *pro forma*, the Examiner's rejections of claims 1-11. We enter a new ground rejection of claims 1-11 under 35 U.S.C. § 112, second paragraph. This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the

examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

The two-month time period for exercising one of the options provided in 37 C.F.R. § 41.50(b) begins to run from the Decided Date shown on the first page of the decision. The time period does not run from the Mail Date (paper delivery) or the Notification Date (electronic delivery).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REVERSED; 37 C.F.R. § 41.50(b)

erc

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